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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,592	12/07/2000	James Michael Fitzpatrick	PIP-53-FITZ-US	9232

31518 7590 05/06/2008  
NEIFELD IP LAW, PC  
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ALEXANDRIA, VA 22304

EXAMINER
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AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

NOTIFICATION DATE	DELIVERY MODE
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05/06/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

general@neifeld.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/730,592	<b>Applicant(s)</b> FITZPATRICK, JAMES MICHAEL	
	<b>Examiner</b> OLABODE AKINTOLA	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/30/2005; 08/31/2007</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

In view of the appeal brief filed on 07/07/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following options:

(1) File a reply under 37 CFR 1.111 (if this office action is non-final) or a reply under 37 CFR 1.113 (if this office action is final); or,

(2) Initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fees and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in the 37 CFR 41.20 have been increased since they were previously paid, then the appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Alexander Kalinowski/

SPE

AU 3691

***Information Disclosure Statement***

The information disclosure statement filed 4/25/2003 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Applicant is requested to submit a PTO 1449 form listing all patents, publications, applications, or other information submitted on the aforementioned date for consideration by the Office.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 40-49, 52 and 55 are directed to a computer program per se or data structure of a computer or software and therefore not statutory under 35 U.S. C. 101. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

Functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system. Compare *Warmerdam* to *In re Lowry* 32 USPQ2d 1031 where a memory with a data structure that increased computing efficiency was patentable.

The computer readable medium loaded with a computer program and in association with a computer provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a transmitter or a receiver), and a piece of paper with the functional descriptive material written on it are all examples of media which are not believed to enable the functionality to be realized with the computer.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites “publishing the price paid database”. It is not clear how a database can be published. Appropriate correction is required.

For examination purposes, the claim will be interpreted as publishing the *content of the* database.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-7, 9, 14-16, 18, 23-25, 28-30, 34-36, 40-41, 44, 46, 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al (US 4972504) in view of Reuhl et al (US 5873069).

Re claims 1, 9, 14, 18, 23-24, 34, 46, 50-51 and 53-55: Daniel teaches a computer-implemented method comprising the steps of: obtaining information from a plurality of retail stores to determine an identification and price paid for purchased items (abstract, col. 6, lines 62-68); recording in a central price-paid database remote from the retail stores at least one of an item identification and the price-paid for each of the purchased items by recurrently obtaining on a predetermined schedule from checkout computers at the retail stores said information about the price paid for purchased items (col. 7, lines 14-45, col. 16, lines 20-55: “*Each such transaction may also include data corresponding to the unique identification code of a participating consumer panelist and may also reflect coupon redemptions, sales taxes, ...*”).

Daniel does not explicitly teach publishing the *content of the* price-paid database. However, Daniel teaches “producing output reports for customers of the market research” (col. 16, lines 54-55). Reuhl, in the same field of art, teaches publishing the content of a database (col. 9, lines 43-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include this feature as taught by Reuhl for the obvious reason of generating a report for market research/analysis purposes.

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Re claims 2 and 25: Daniel/Reuhl teaches wherein the step of obtaining the information comprises: obtaining customer identification associated with each purchased item (Daniel: col. 19, lines 36-56, col. 7, lines 14-45; Reuhl: col. 7, lines 15-21, 40-55 and col. 10, lines 15-32).

Re claims 5 and 28: Daniel teaches wherein the step of obtaining the information comprises: recording the identification and the price paid for each of the purchased items in the checkout computer; and recurrently uploading the recorded identification and the price-paid to a central computer containing the price-paid database (col. 19, lines 36-56, col. 7, lines 14-34).

Re claims 6, 15, 29, 35 and 44: Daniel does not explicitly teach comparing the price paid to an inventory list price; recording at least one of the inventory list price and a price differential between the inventory list price and the price paid; and recurrently uploading the at least one of the inventory list price and the price differential to the central computer. Reuhl, in the same field of art, teaches comparing the price paid to an inventory list price; recording at least one of the inventory list price and a price differential between the inventory list price and the price paid; and recurrently uploading the at least one of the inventory list price and the price differential to the central computer (abstract, col. 3, lines 1-67, col. 4, lines 35-60, col. 7, lines 15-21, col. 10, lines 15-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include these features as taught by Reuhl in order to get the benefit of inventory price comparison with other quoted prices.



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Re claims 7, 16, 30 and 36: Daniel further teaches recording at least one of the customer identification and a store identification; and recurrently uploading the at least one of the customer identification and a store identification to the central computer (col. 7, lines 14-34, col. 16, lines 20-55, col. 19, lines 36-56).

Re claims 40, 41 and 52: Daniel teaches storing an item identification corresponding to an item purchased from the plurality of retail stores; storing the price paid for said item purchased; and storing customer identification (col. 7, lines 19-45; col. 19, lines 36-56). Daniel does not explicitly teach the use of fields. However, Reuhl teaches the use of fields (col. 3, lines 5-67, col. 4, lines 35-55 and col. 7, lines 5-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include plurality of fields because the use of fields in database is well known in the database art for interpreting, processing and storing information in the database.

Claims 8, 10-13, 17, 19-22, 31-33, 37-39, 45 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al in view of Reuhl et al, and further in view of Riordan (US 6078891)

Re claims 8, 17, 31-32, 37-38 and 45: Daniel does not explicitly teach wherein the step of recording comprises: formatting the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid, the list price, and the price differential. Riordan

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teaches formatting the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid (columns 7, 9 and 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include these features as taught by Riordan. Formatting data into columnar entries provides for better understanding of the relationship between the various entries in the database for analytical purposes.

Reuhl teaches list price and the price differential (abstract, col. 3, lines 1-67, col. 4, lines 35-60, col. 7, lines 15-21, col. 10, lines 15-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include these features as taught by Reuhl in order to compare prices for market research purposes.

Re claims 10-13, 19-22, 33, 39 and 47-49: Daniel does not explicitly teach wherein the step of providing comprises: selecting from the web page price-paid information from at least one of a store selection, a customer selection, a brand selection, and a sales category selection within a specified district; wherein the step of selecting comprises: determining one of a zip code and an area code of the user; and restricting the specified district to an area within the one of a zip code and an area code; determining one of a remote district, a regional district, and a national district for the user; and restricting the specified district to an area within the one of a remote district, a regional district, and a national district; selecting from the web page price-paid information from stores within a specified district. However, in col. 4, lines 25-45, col. 5, lines 1-15, col. 6, lines 40-65, col. 10, lines 1-15 thereof, Riordan teaches specific data information. Therefore, it would

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have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel in view of Reuhl based on the teachings of Riordan for the benefit of price comparison, trends analyses and for market analysis purposes.

Claims 3, 26 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al in view of Reuhl et al, and further in view of Sloane (US 5918211)

Re claims 3, 26 and 42: Daniel does not explicitly teach wherein the step of: obtaining customer identification comprises: scanning at least one of a frequent shopper card, a credit card, a club member card, and a debit card. Sloane teaches obtaining customer identification by scanning a frequent shopper card (col. 3, lines 32-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include this feature as taught by Sloane for the obvious reason of allowing the customer to take advantage of any discount, credits, rewards or promotion contained in the shopper's account.

Claims 4, 27 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al in view of Reuhl et al, and further in view of Day et al (US 5857175)

Re claims 4, 27 and 43: Daniel does not explicitly teach wherein the step of obtaining customer identification comprises: scanning at least one of a fingerprint, retinal scan, and a signature.

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Day teaches identifying a customer using fingerprint scanning (col. 4, lines 25-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include this feature as taught by Day for the obvious reason of providing alternative means of identifying the customers.

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
Supervisory Patent Examiner, Art Unit  
3691

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